



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/063,236
Applicant: Webber
Confirmation No.: 5209
Filed: April 2, 2002
Group Art Unit: 2873
Examiner: Martinez, Joseph P.

Attorney Docket No.: H-317
Customer No.: 26245

Cambridge, Massachusetts
May 17, 2005

RESPONSE TO OFFICE ACTION

Mail Stop Amendment
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

In response to the Office Action issued December 14, 2004 in connection with the above application, the following arguments are submitted; there are no amendments to the description, claims or drawings.

Claims 1-28 are pending in the application. No claim is allowed, and no claim is objected to. All claims stand rejected under 35 USC 103(a) as unpatentable over Albert et al., U.S. Patent No. 6,017,584, in view of Herb et al., U.S. Patent No. 6,693,620.

The 35 USC 103(a) is traversed. More specifically, this rejection is traversed on the grounds that (a) the use of Herb to support a 35 USC 103(a) rejection is barred by 35 USC 103(c); and (b) Albert does not describe the use of polyisobutylene (PIB) dissolved or dispersed in the suspending fluid of an electrophoretic medium.

With regard to point (a), Herb was issued and published only on February 17, 2004, long after the April 2, 2002 filing date of the present application; there was no earlier publication of Herb as an application. Hence, the only basis on which Herb can be cited as prior art is 35 USC 102(e). However, 35 USC 103(c) provides that subject matter

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developed by another, which qualifies as prior art only 35 USC 102(e), shall not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. According to Office records, Herb was assigned to E Ink Corporation, of 733 Concord Avenue, Cambridge MA 02138 by an Assignment recorded at Reel 10893, Frames 643-647. The present application was assigned to the same E Ink Corporation by an Assignment recorded at Reel 12541, Frames 561-563. Furthermore, the undersigned attorney, who is the Intellectual Property Counsel of E Ink Corporation, can state, of his own personal knowledge, that the inventors of both Herb and the present application were at all relevant times employed by E Ink Corporation under contracts of employment which required them to assign their inventions to that corporation. Accordingly, Herb and the present application are commonly owned within the meaning of 35 USC 103(c) and use of Herb as prior art to support a 35 USC 103(a) rejection is barred by 35 USC 103(c).

This point alone should be sufficient to cause withdrawal of the 103 rejection, since there is no suggestion in the Office Action that this rejection could be founded on Albert alone. However, for the sake of completeness, the undersigned would also point out that the interpretation of Albert in the Office Action is incorrect, and that Albert does not describe the use of PIB dissolved or dispersed in the suspending fluid of an electrophoretic medium.

The applicant agrees with the Examiner that Albert teaches an electrophoretic medium comprising a plurality of particles suspended in a suspending fluid and capable of moving through the fluid upon application of an electric field to the medium. However, the applicant does not agree Albert describes a polymer, much less PIB, dissolved or dispersed in the suspending fluid.

The passage at column 2, lines 27-28, to which the Examiner directs attention, does not describe the dissolution or dispersion of a polymer in the suspending fluid of an electrophoretic medium. The full passage at column 2, lines 23-32 describes

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what is known as a "polymer-dispersed electrophoretic display" (or medium) in which the electrophoretic fluid (comprising the electrophoretic particles and the suspending fluid) is directly dispersed or emulsified in a binder or binder precursor, so that there are no discrete capsule walls surrounding each droplet of electrophoretic fluid; instead, the binder or binder precursor forms a continuous phase encapsulating a large number of discrete droplets of electrophoretic fluid. This type of polymer-dispersed electrophoretic medium is described in more detail and illustrated in, for example, U.S. Patent No. 6,866,760 (copy enclosed - note that the application which issued as this patent was filed by the undersigned attorney approximately one month before the filing of the present application).

The presence of binder in the continuous phase of such a polymer-dispersed electrophoretic medium does not imply that the polymer dissolves or disperses in the suspending fluid. On the contrary, such dissolution or dispersion should obviously be avoided, since it removes polymer from the continuous phase and hence might cause undesirable leakage of electrophoretic fluid from the discontinuous phase to the external surfaces of the medium,

The passage at Albert, column 14, line 55, to which the Examiner also drew attention, similarly has nothing to do with PIB dissolved or dispersed in the suspending fluid of an electrophoretic medium, nor does it relate to the same subject matter as the earlier passage at column 2, lines 27-28 discussed above. As should be clear from the sub-heading at column 12, line 54, the whole passage from column 12, line 54 to column 15, line 60 relates to materials for use in electrophoretic particles, not additives to the suspending fluid. More specifically, the passage at column 14, line 28 to column 15, line 9 relates to electrophoretic particles comprising a combination of pigments and polymers. Column 14, line 55 mentions that the polymer used in such composite electrophoretic particles may be PIB. However, clearly a polymer used in such a composite electrophoretic particle should not be soluble in the suspending fluid, or the composite particle would fall apart as the polymer dissolves. Accordingly, column 14,

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line 55 does not teach or imply that PIB should be present in the suspending fluid. Furthermore, since the earlier passage in column 2 refers to use of a polymer as an external phase binder, while the passage in column 15 relates to use of PIB within an electrophoretic particle, it is respectfully submitted that it is entirely illogical to combine the two passages, as the Office Action attempts to do.

For the foregoing reasons, the 35 USC 103(a) rejection is unjustified and should be withdrawn.

Reconsideration and allowance of all claims in this application is respectfully requested.

Since the normal period for responding to the Office Action expired March 14, a Petition for a three-month extension of this period is filed herewith. As a result of a review by the undersigned attorney of certain business transactions entered into by the assignee of this application, it has been determined that this application is now entitled to small entity status, and accordingly the fee for the Petition is being paid at the small entity rate. It is respectfully requested that the relevant Office records be amended accordingly.

Respectfully submitted



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